

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

GEBAUER *et al.*

Appl. No.: 10/561,174

Filed: June 6, 2006

For: **Triazolopyrimidines**

Confirmation No.: 1957

Art Unit: 1609

Examiner: MURRAY, Jeffrey H.

Atty. Docket: 2400.0090000/VLC/BSA

Reply to Restriction Requirement and Requirement for Election of Species

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated May 7, 2007, requesting an election of one invention to prosecute in the above-referenced patent application, Applicant hereby provisionally elects to prosecute the invention of Group I, represented by claims 1-3 and 5.

This election is made **with traverse**.

Initially Applicants note that there are two groups referred to as group VI. It is also not clear which claim(s) fall within the first group VI since claim 1 is not a method claim. Claim 4 is directed to a method of preparing compounds of claim 1. However, claim 4 has not been included in any of the groups to which the application is restricted. It would appear that the examiner intended to place claim 4 in the first of the two group(s) VI. Applicants respectfully request clarification of the restriction requirement for the first of the two group(s) VI.

According to the examiner, the core triazolopyrimidine structure of compounds of formula (I) is taught by, among other references, U.S. patent 6,576,411 (the '411 patent). However, claim 1 of the present application requires that the R³ group of the compound of formula (I) is a heterocyclic group whereas the group corresponding to R³ in the '411 patent is a bromide. Thus, the core structure in the present claims is a 6-heterocycle-substituted triazolopyrimidine, which is not described in the '411 patent.

Moreover, claims 9, 10 and 11 (groups II, III and VII) are directed to compounds with the same 6-heterocycle-substituted triazolopyrimidine core structure.

The criteria for a proper requirement for restriction are that (1) the inventions must be independent or distinct as claimed; *and* (2) there must be a serious burden on the Examiner if restriction is not required. M.P.E.P. § 803 (emphasis added). The two requirements for restriction set forth in M.P.E.P. § 803 are connected with "and." Accordingly, satisfaction of both criteria is required for a proper restriction requirement.

Applicants respectfully assert that the Examiner has not fully satisfied at least one of the criteria of 35 U.S.C. § 121 with respect to the restriction between groups I-III, and group VII.

Because searching groups I-III and group VII would involve searching the same class of compounds, there is no serious burden placed on the Examiner to examine groups I-III and group VII together. Moreover, the Examiner has not shown by appropriate explanation that a serious burden will exist if restriction were not required. Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

Further, the compounds prepared or used in the claims of groups VI-VIII and XI are the same class of compounds as those claimed in the elected group I. Thus, because an Examiner's search of the method and process claims of groups VI-VIII and XI would necessarily uncover any art disclosing the limitations of group I, searching groups I, VI-VIII and XI together does not put a serious burden on the Examiner. Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

Even if the restriction between group I and groups VI and XI were proper, groups VI and XI should be rejoined once the Examiner finds that group I is allowable. Under MPEP §821.04, where elected claims are found allowable, withdrawn claims that require all the limitations of an allowable claim will be rejoined and fully examined for patentability. Rejoinder of groups VI and XI is respectfully requested. Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

Applicants also hereby provisionally elect the species of example 2. Claims 1- 5, 7, and 8 (of groups I, VI and XI) read on such species. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

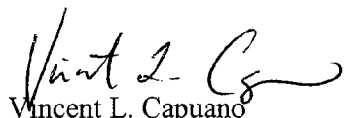
This election is made **with traverse**. The technical feature linking all the compounds of formula (I) is the presence of the R³ heterocyclic group.

Reconsideration and withdrawal of the Requirement for Election of Species, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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